

### **REMARKS/ARGUMENTS**

These Remarks are responsive to the Office Action mailed June 12, 2003 ("Office Action"). Applicant respectfully requests reconsideration of the rejections of claims 1-30 for at least the following reasons.

#### **STATUS OF THE CLAIMS**

Claims 1-30 are pending in the application.

Claim 1 is amended. No new matter is added by these amendments.

#### **REJECTIONS UNDER 35 U.S.C. § 112**

The Examiner asserts that claim 1 repeats limitations such as the analyzing step and the notification step. Claim 1 has been amended to remove the repeated notification step. As to the analysis step, the first analysis step applies to the model system and the second refers to the production system. Thus these two steps are not repetitive because they are performed on two different systems. Applicant respectfully request that the rejection be withdrawn.

#### **REJECTIONS UNDER 35 U.S.C. § 102**

The Office Action has rejected claims 1-3, 5-7, 9-18, 20-22, 24-30 under 35 U.S.C. §102(a), as being anticipated by Hossain et al. United States Patent Number 5,581,749. Hossain does not teach or suggest a model software system and a separate production software system. For example, in independent claims 1 and 16, the first analysis step occurs on the model system and the second analysis step occurs on the production system. Hossain does not teach or suggest enhancements occurring on a model system which is an equivalent of the productions system. Applicant respectfully request that the rejection be withdrawn.

Claims 3, 5-7, 9-15 and 18, 20-22, and 24-30 depend from allowable claims 1 and 16 as demonstrated above. Applicants respectfully request that the rejection be withdrawn.

The Examiner asserts that claims 2 and 17 are anticipated by Hossain specifically at col. 13, lns. 55-65. Claim 2 recites "a program module or a modified program module." Hossain

does not teach or suggest a program module. Hossain discloses updating key values and/or records rather than a program module. The issues faced by a system updating a record are of a different kind than issues associated with updating a program module. For example, updating a program module may include reviewing Job Control Language (JCL) or source control data. JCL and source control data are not relevant to a simple key value or a record. Applicants respectfully request that the rejection be withdrawn.

#### REJECTIONS UNDER 35 U.S.C. § 103

Claims 4, 8, 19 & 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hossain et al. United States Patent Number 5,581,749 hereinafter in view of May et al. United States Patent Number 5,999,741.

Hossain and May are improperly combined. In order to support a § 103 rejection based on a combination of references, the Examiner must provide a sufficient motivation for making the relevant combinations. *See* M.P.E.P. §§ 2142 and 2143.01; *see also In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998) (“When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.”). It is well-settled that an Examiner can “satisfy [the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness] only by showing some *objective teaching* in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) (emphasis added); *see also In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) (“deficiencies of the cited references cannot be remedied by the Board’s general conclusions about what is ‘basic knowledge’ or ‘common sense’”). As with rejections based on the modification of a single reference, “[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence [of a motivation to combine]’” and thus do not support rejections based on combining references. *In re Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. Without objective evidence of a motivation to combine, the obviousness rejection is the “essence of hindsight” reconstruction, the very “syndrome” that the requirement for such evidence is

designed to combat, and without which the obvious rejection is insufficient as a matter of law. *Id.* at 999, 50 USPQ2d at 1617-18.

There is no showing of any objective teaching to combine the references in the Office action. The Office action merely states: "to modify Hossain with May because, scheduling during updating or software enhancing makes applying enhancements to a system more time efficient and less conflicting." This broad, conclusory statement is not sufficient, under the controlling authorities set forth above, to justify combining the teachings of Hossain and May. Indeed, this broad, conclusory statement is nothing more than the Examiner's speculation on what could possibly be achieved if the references could be combined. In fact, a person of ordinary skill in the art would not be motivated to combine the teachings of Hossain and May. Specifically, Hossain attempts to solve the problem of updating records and key values. In contrast, May attempts to deal with updating software. The challenges associated with updating software are different than those associated with updating records. For at least the following reasons, applicants respectfully submit that the rejections of claims 2, 6, 7, 8, 24, 28, and 31 based on this combination are improper and therefore should be withdrawn for at least this reason.

### CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding rejections have been overcome or rendered moot. Further, all pending claims are patentably distinguishable over the prior art of record, taken in any proper combination. Reconsideration and allowance of the instant application are respectfully requested.

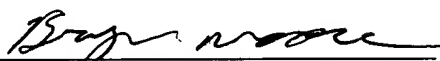
If the Examiner has any remaining informalities to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such informalities

Respectfully submitted,

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